



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,621	08/24/2005	Thomas Rueckle	263675US0PCT	2551
22850	7590	09/18/2007	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.			KOSACK, JOSEPH R	
1940 DUKE STREET			ART UNIT	PAPER NUMBER
ALEXANDRIA, VA 22314			1626	
			NOTIFICATION DATE	DELIVERY MODE
			09/18/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/520,621	Applicant(s) RUECKLE ET AL.	
	Examiner Joseph Kosack	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 7,10-16,20-23 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,9,17,18 and 28-34 is/are rejected.
- 7) ☒ Claim(s) 19,24-27,35 and 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/15/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-37 are pending in the instant application.

Election/Restrictions

Applicant's election without traverse of the species of Example 19 of the specification in the reply filed on July 3, 2007 is acknowledged.

As a rejection can be made on the elected species in at least one claim, the search has been currently restricted to the elected species and any associated methods. Therefore, claims 7, 10-16, 20-23, and 36 are withdrawn in full by the Examiner under 37 CFR 1.142(b) as being drawn to non-elected inventions. Additionally, claims 1-6, 8-9, 17-19, 24-35, and 37 are withdrawn in part by the Examiner under 37 CFR 1.142(b) as being drawn to non-elected inventions.

Priority

The claim to priority as a 371 filing of PCT/EP03/50302, filed July 10, 2003, which is a CIP of 10/289,998 filed November 7, 2002, and claims priority to EP 02100798.4, filed July 10, 2002 is acknowledged in the instant application.

Information Disclosure Statement

The Information Disclosure Statement filed March 15, 2005 has been considered fully by the Examiner.

Claim Objections

Claims 1-6, 8-9, 17-19, 24-35, and 37 are objected to for containing elected and non-elected subject matter. The elected subject matter has been identified supra.

Art Unit: 1626

Applicant is advised that additional subject matter may be searched after all rejections are removed from the elected species.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6, 8-9, 17-18 and 28-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In *In re Wands*, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. § 112, first paragraph, have been described. They are:

1. the nature of the invention,
2. the state of the prior art,
3. the predictability or lack thereof in the art,
4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quantity of experimentation needed, and
8. the level of the skill in the art.

The Nature of the Invention

The nature of the invention is the treatment of a wide variety of disorders ranging from autoimmune disorders to cancer to viral infections to cardiovascular disease.

The State of the Prior Art and the Predictability or Lack Thereof in the Art

The state of the prior art is that it involves screening *in vitro* and *in vivo* to determine which compounds exhibit the desired pharmacological activities (i.e. what compounds can treat which specific disease). There is no absolute predictability even in view of the seemingly high level of skill in the art. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any therapeutic regimen on its face.

The instant claimed invention is highly unpredictable as discussed below:

It is noted that the pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed for physiological activity. In *re Fisher*, 427 F.2d 833, 166 USPQ 18 (CCPA 1970) indicates that the more unpredictable an area is, the more specific enablement is necessary in order to satisfy the statute. In the absence of clinical data to enable the invention, there needs to be a clear cause and effect relationship between inhibiting an enzyme and the effect that that inhibition causes. Applicant, while alleging that the compound can treat many widely varied diseases, fails to show that using the compound to inhibit PI3K would actually treat or prevent the diseases. While kinases have become more palatable targets of recent pharmaceutical research, there is a lot about the function of kinases that is unknown. In fact, Applicant states on page 7 of the disclosure that "it remains unclear which particular PI3K isoform or isoforms are involved in these phenomena." Applicant states that the intended target of the compounds is PI3K-gamma, a particular isoform of PI3K. Has it been shown in the art that inhibiting this particular isoform would treat or prevent the claimed diseases? Will

Art Unit: 1626

inhibition have any effect on the human body? The documents cited by Applicant in the IDS of March 15, 2005 along with the disclosure do not shed much light on these questions. The person of skill who would practice this invention must know the answers or else they would require extensive undue experimentation to work out the proper doses to treat the claimed diseases.

Additionally, the claims are drawn to the prophylaxis of many various diseases. Prophylaxis includes the outright prevention of the diseases from even happening. Prevention, if undefined by the specification, means that the condition or disease will *never* occur as a result of administration of the compound. For example, as the claims read now, this compound would prevent an infectious bacterium from ever entering the body, let alone cause any adverse symptoms. Also, different doses may be needed as a preventative than for treating a particular condition. Applicant does not provide guidance as to how the dosing would change if being given in a preventative dose.

Hence, in the absence of a showing of correlation in the art between all the diseases claimed as capable of treatment by antagonizing PI3K-gamma, one of skill in the art is unable to fully predict possible results from the administration of the compound of claim 1 due to the unpredictability of the role of antagonizing PI3K-gamma.

The Amount of Direction or Guidance Present and the Presence or Absence of Working

Examples

The specification provides an assay for PI3K-gamma activity for particular compounds of the invention on page 121 of the disclosure, but do not show any evidence of the effectiveness at treating or preventing diseases.

The Breadth of the Claims

The breadth of the claims is the treatment of various diseases, whether or not they are mediated by PI3K-gamma inhibition.

The Quantity of Experimentation Needed

The quantity of experimentation needed is undue experimentation. One of skill in the art would need to determine the proper dose to deliver to a patient to treat a claimed disease with no knowledge as to how inhibiting PI3K-gamma actually treats the disease.

The Level of Skill in the Art

The level of skill in the art is high. However, due to the unpredictability in the pharmaceutical art, it is noted that each embodiment of the invention is required to be individually assessed for physiological activity by in vitro and in vivo screening to determine which compounds exhibit the desired pharmacological activity and which diseases would benefit from this activity.

Thus, the specification fails to provide sufficient support of the broad use of the compound of claim 1 for the treatment of diseases mediated by antagonizing PI3K-gamma. As a result, necessitating one of skill to perform an exhaustive search for which diseases can actually be treated by what compounds of claim 1 in order to practice the claimed invention.

Genentech Inc. v. Novo Nordisk A/S (CA FC) 42 USPQ2d 1001 , states that " a patent is not a hunting license. It is not a reward for search, but compensation for its successful conclusion" and "[p]atent protection is granted in return for an enabling

Art Unit: 1626

disclosure of an invention, not for vague intimations of general ideas that may or may not be workable".

Therefore, in view of the Wands factors and *In re Fisher* (CCPA 1970) discussed above, to practice the claimed invention herein, a person of skill in the art would have to engage in undue experimentation to test which diseases can be treated by the compound encompassed in the instant claims, with no assurance of success.

This rejection can be overcome deleting the claims or by amending the claims to be limited to treating (not preventing) diseases that have a *clear* correlation to inhibiting (antagonizing) PI3K-gamma.

Conclusion

Claims 1-6, 8-9, 17-18 and 28-34 are rejected. Claims 1-6, 8-9, 17-19, 24-35, and 37 are objected to.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Kosack whose telephone number is (571)-272-5575. The examiner can normally be reached on M-F 6:30 A.M. until 4:00 P.M. The examiner has every other Friday off.

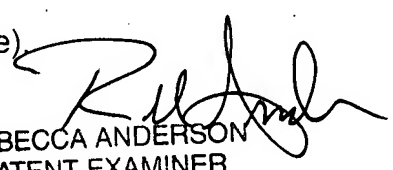
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1626


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph Kosack
Patent Examiner
Art Unit 1626



REBECCA ANDERSON
PATENT EXAMINER



Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626